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PTO/SB/21 (09-04)

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# TRANSMITTAL FORM

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Total Number of Pages in This Submission

Application Number	10/821,741
Filing Date	April 9, 2004
First Named Inventor	Stuffle et al.
Art Unit	2875
Examiner Name	William J. Carter
Attorney Docket Number	SCH-00086

## ENCLOSURES (Check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement  <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Return Receipt Postcard
<div>Remarks</div>		

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Warn, Hoffmann, Miller & LaLone, P.C.		
Signature			
Printed name	Philip R. Warn		
Date	May 22, 2006	Reg. No.	32775

## CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature			
Typed or printed name	Philip R. Warn - Reg. No. 32775	Date	May 22, 2006

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PTO/SB/17 (12-04v2)

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# FEE TRANSMITTAL

## For FY 2005

☐ Applicant claims small entity status. See 37 CFR 1.27TOTAL AMOUNT OF PAYMENT (\$)  
500.00**Complete if Known**

Application Number	10/821,741
Filing Date	April 9, 2004
First Named Inventor	Stuffle et al.
Examiner Name	William J. Carter
Art Unit	2875
Attorney Docket No.	SCH-00086

**METHOD OF PAYMENT (check all that apply)**☒ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): \_\_\_\_\_☒ Deposit Account Deposit Account Number: 501612 Deposit Account Name: Warn, Hoffmann, Miller & LaLone, P.C.

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☐ Charge fee(s) indicated below☐ Charge fee(s) indicated below, except for the filing fee☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17☒ Credit any overpayments

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**FEE CALCULATION****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

**2. EXCESS CLAIM FEES****Fee Description**

	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

**Total Claims**      **Extra Claims**      **Fee (\$)**      **Fee Paid (\$)**

- 20 or HP = \_\_\_\_\_ x \_\_\_\_\_ = \_\_\_\_\_

HP = highest number of total claims paid for, if greater than 20.

**Indep. Claims**      **Extra Claims**      **Fee (\$)**      **Fee Paid (\$)**

- 3 or HP = \_\_\_\_\_ x \_\_\_\_\_ = \_\_\_\_\_

HP = highest number of independent claims paid for, if greater than 3.

**3. APPLICATION SIZE FEE**

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

<b>Total Sheets</b>	<b>Extra Sheets</b>	<b>Number of each additional 50 or fraction thereof</b>	<b>Fee (\$)</b>	<b>Fee Paid (\$)</b>
_____	_____	_____	_____	_____

- 100 = \_\_\_\_\_ / 50 = \_\_\_\_\_ (round up to a whole number) x \_\_\_\_\_ = \_\_\_\_\_

**4. OTHER FEE(S)**

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Appeal Brief**Fees Paid (\$)**500.00**SUBMITTED BY**

Signature

Registration No. 32775  
(Attorney/Agent)

Telephone (248) 364-4300

Name (Print/Type) Phillip R. Warn

Date March 20, 2006

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application No. 10/821,741  
Filing Date: April 9, 2004  
Applicant: Werner Stuffle  
Group Art Unit: 2875  
Examiner: William J. Carter  
Title: LOUDSPEAKER UNIT WITH SOURCE OF LIGHT  
Attorney Docket: SCH-00086

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**APPEAL BRIEF**

Sir or Madam:

This is an Appeal Brief in response to the Examiner's Advisory Action Before the Filing of an Appeal Brief mailed March 10, 2006 rejecting claims 1-10. A Notice of Appeal was received by the Patent Office on March 24, 2005. The Appeal Brief is submitted in triplicate. Any needed extension of time is hereby requested with the filing of this document.

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### **Real Party in Interest**

The Real Party in Interest is Reitter & Schefenacker Sound GMBH a German corporation, having a place of business at, Wolf-Hirth-Strasse 9, Esslingen, Germany, D-73730 is the Assignee of Record, at Reel 015613/0352.

### **Related Appeals and Interferences**

There are no related Appeals or Interferences in the subject application.

### **Status of Claims**

In response to the Appellants response to Office Action mailed December 22, 2005, claims 1-10 are pending and now currently the subject of this Appeal.

### **Status of Amendments**

The response to Office Action dated February 22, 2006 submitted amendments to the claims in order to overcome claim objections to claim 1 of the application. More specifically claim 1 was amended at line 5 to change the word "the" in front of "diaphragm" to recite "a diaphragm". Additionally, at line 5 of claim 1 the word "the" in front of "direct-current network" to recite "a direct-current network". The claim amendments were entered as indicated in the Advisory Action mailed on March 10, 2006.

### **Summary of the Claimed Subject Matter**

A speaker unit (10) for use in a motor vehicle having at least one speaker (11) which has a chassis (13). ¶ [0019]; Figs. 1-6. At least one light source (21) installed in the chassis (13) of the speaker (11). ¶ [0008]; Fig. 1. The light source (21) is located outside of a diaphragm (16) and is electrically connected to a direct-current network on board the motor vehicle. *Id.*

The light source (21) can be screwed into the chassis (13) or it may be soldered into the chassis (13). ¶ [0020]. Speaker unit (10) can also comprise a single electrical intersection with the vehicle circuit.

The light source (21) can be arranged in parallel to the axis (15) of the speaker (11). See Figs. 1, 2, 3, 5 and 6. Or the light source (21) may be arranged perpendicular to the axis (15) of the speaker (11). ¶ [0031]; Fig. 4.

The light source (21) can also be followed by dispersion disk (18). ¶ [0033]; Fig. 6. The light source (21) can also be a light emitting diode. ¶ [0020]. The light emitting diode and a light transmissive material (18) can form a single component. ¶ [0033]; Fig. 6. The speaker unit (10) can also comprise a light transmissive material (18) adjacent the light emitting diode (21) for allowing light to be dispersed into the interior of the vehicle. ¶ [0038].

### **Grounds of Rejection to be Reviewed on Appeal**

1. Whether the combination of U.S. Patent No. 6, 545,418 to Kolpasky in view of U.S. Patent No. 6,158,869 to Barnes to render claims 1 and 4-10 obvious under 35 U.S.C. § 103(a).



2. Whether the combination of U.S. Patent No. 6,454,418 to Kolpasky in view of U.S. Patent No. 6,158,869 to Barnes and further in view of U.S. Patent No. 5,964,519 to Chun-Ying render claim 2 obvious under 35 U.S.C. § 103(a).

3. Whether the combination of U.S. Patent No. 6,454,418 to Kolpasky in view of U.S. Patent No. 6,158,869 to Barnes and further in view of U.S. Patent No. 6,283,414 to Quinones render claim 3 obvious under 35 U.S.C. §103(a).

### **Arguments**

#### **Whether Claims 1 and 4-10 are rendered Obvious under 35 U.S.C. § 103(a)**

Claims 1 and 4-10 were rejected under 35 USC §103(a) as being unpatentable over U.S. Patent No. 6, 545,418 to Kolpasky hereafter (Kolpasky '418) in view of U.S. Patent No. 6,158,869 to Barnes (hereafter Barnes '869). Claims 1 and 4-10 contain the limitation of "...at least one light source being installed in the chassis of a speaker outside of a diaphragm..." See claim 1 from which claims 4-10 depend. Applicant maintains that the combination of Kolpasky '418 in view of Barnes '869 does not teach or suggest this limitation.

The Final Office Action indicated that Kolpasky '418 taught all of the elements of claim 1 except for "...at least one light source installed outside of the diaphragm." Final Office Action page 2. The Office Action then indicated that "Barnes, drawn to light attachment to speakers, teaches at least one light source (18) installed outside of the diaphragm (Fig. 2). It would not have been obvious to one of ordinary skill in the art, at

the time of the invention, to use the light configuration of Barnes '869 in the speaker of Kolpasky '418, in order to achieve the best possible lighting for intended surface (abstract)." Final Office Action pages 2-3.

Applicant maintains that the combination of Kolpasky '418 in view of Barnes '869 does not teach or suggest at least one light source being installed in the chassis of a speaker outside of a diaphragm as required by claims 1 and 4-10 of the present application. In order for the proposed combination of references to render the claim of an application obvious a prima facie case of obviousness must be set forth. In other words, the standard of obviousness is that there must be some suggestion, either in the reference or in the relevant art, of how to modify what is disclosed to arrive at the claimed invention. In addition, "[s]omething in the prior art as a whole must suggest the desirability and, thus, the obviousness of making" the modification to the art suggested by the Examiner. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 U.S.P.Q.2d (BNA) 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988). Although the Examiner may suggest the teachings of a primary reference could be modified to arrive at the claimed subject matter, the modification is not obvious unless the prior art also suggests the desirability of such modification. *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d (BNA) 1397, 1398 (Fed. Cir.1989). There must be a teaching in the prior art for the proposed combination or modification to be proper. *In re Newell*, 891 F.2d 899, 13 U.S.P.Q.2d (BNA) 1248 (Fed. Cir. 1989). If the prior art fails to provide this necessary teaching, suggestion, or incentive supporting the Examiner's suggested modification, the rejection based upon this suggested modification is error

and must be reversed. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d (BNA) 1566 (Fed. Cir. 1990).

Kolpasky '418 teaches or suggests an illuminating speaker assembly. See Kolpasky '418 Abstract. There is nothing in the specification or drawings of Kolpasky '418 which teach or suggest at least one speaker in a chassis, nor does Kolpasky '418 teach or suggest a diaphragm member. Instead the specification of Kolpasky '418 teaches a housing (14) of an illuminating speaker assembly (12), however, there is no discussion nor are there any structures in the figures which show where the sound is generated from. Therefore, Kolpasky '418 does not teach or suggest a speaker unit or a diaphragm for a speaker unit. Barnes '869 also fails to teach or suggest "at least one light source being installed in the chassis of a speaker outside of the diaphragm..." as requested by claims 1 and 4-10 of the present application. Barnes '869 teaches an apparatus that integrates pedal and foot well lighting in a vehicle with a speaker grille. See Barnes '869 Abstract. Barnes '869 states "[m]embers 30, 32 are arranged so as to be longitudinally parallel to the path of the acoustic energy generated by the audio device." Col. 3, lines 49-51. The specification of Barnes '869 also states "[d]iodes 52 are connected to one another by a porous metal plate or slotted wiring 54 to allow a maximum amount of sound to be transmitted from the audio device through device 18." Col. 4, lines 60-65. Barnes '869 does not teach a diaphragm structure. Furthermore, Barnes '869 teaches sound being transmitted through the light emitting device (18). This suggests that the light emitting device (18) is not outside of the diaphragm, which is required by rejected claims 1 and 4-10.

For all of the above reasons Applicant argues that there is no teaching in the proposed combination of references that would even suggest modifying them to arrive at the combination of elements contained in the present application. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 U.S.P.Q.2d (BNA) 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988). Clearly there must be some sort of teaching in the prior art for the proposed combination or modification to be proper. *In re Newell*, 891 F.2d 899, 13 U.S.P.Q.2d (BNA) 1248 (Fed. Cir. 1989). Applicant can only conclude that the Examiner has impermissibly used hindsight to argue that "...at least one light source being installed in the chassis of a speaker outside of a diaphragm..." as recited by rejected claims 1 and 4-10, is taught or suggested by the proposed combination of Kolpasky '418 in view of Barnes '869. Clearly the Examiner has impermissibly used "hindsight" and used the Applicant's teaching as a blueprint to hunt through the prior art for the claimed element and to combine them as claimed. *In re Zirko* 111 F. 3d 887, 42 U.S.P.Q. 2d 1476 (Fed. Cir. 1997). For all of the above reasons Applicant requests removal of the rejection of claims 1 and 4-10 as being rendered obvious by the combination of Kolpasky '418 in view of Barnes '869.

In further regard to claim 5 Applicant further argues that both Kolpasky '418 in view of Barnes '869 fail to teach or suggest a light source being arranged parallel to the axis of the speaker. See claim 5 of the present application. The specification and drawings of Kolpasky '418 do not show where the speaker is located, therefore, it is impossible to know whether or not the light source is arranged parallel to its axis. Barnes '869 does not fill the void left by Kolpasky '418. Fig. 3 of Barnes '869 shows the light source being at a downward angle with respect to the lens (48). This suggests that

the light source is not parallel to the axis of the speaker. Therefore Kolpasky '418 in view Barnes '869 fail to teach or suggest a limitation set forth in claim 5 of the present application.

In further regard to claim 6 of the present applicant points out that claim 6 contains the limitation of the light source being arranged perpendicular to said axis of the speaker. Kolpasky '418 cannot teach or suggest the light source being arranged perpendicular to the axis of the speaker since Kolpasky '418 does not show the location of the speaker in the drawings or in the specification. Fig. 2 of Barnes '869 shows the light source being located at what appears to be an angle with respect to the axis of the speaker and therefore does not teach or suggest arranging the light source perpendicular to the axis. Therefore, the limitations of claim 6 are not taught or suggested by Kolpasky '418 in view of Barnes. Clearly the Examiner has once again impermissibly used "hindsight" by using the Applicant's teaching as a blueprint to hunt through the prior art for the claimed elements and to combine them as claimed. *In re Zirko* 111 F.3d 887, 42 USPQ 2d 1476 (Fed. Cir. 1997). Removal of the rejection and allowance of claim 6 is respectfully requested.

**Whether Claim 2 is rendered Obvious under 35 U.S.C. § 103(a)**

Claim 2 was rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,454,418 to Kolpasky (hereafter Kolpasky '418) in view of U.S. Patent No. 6,158,869 to Barnes (hereafter Barnes '869) and further in view of U.S. Patent No. 5,964,519 to Chun-Ying (hereafter Chun-Ying '519) render claim 2 obvious under 35

U.S.C. § 103(a). Claim 2 contains the limitation of “at least one light source being installed in the chassis of a speaker **outside of the diaphragm.**” [emphasis added].

The Final Office Action indicated that Kolpasky ‘418 taught all of the elements of claim 2 except for “...at least one light source installed outside of the diaphragm.” Final Office Action page 2. The Office Action then indicated that “Barnes, drawn to light attachment to speakers, teaches at least one light source (18) installed outside of the diaphragm (Fig. 2). It would not have been obvious to one of ordinary skill in the art, at the time of the invention, to use the light configuration of Barnes ‘869 in the speaker of Kolpasky ‘418, in order to achieve the best possible lighting for intended surface (abstract).” Final Office Action pages 2-3. Furthermore the Final Office Action relied upon Chun-Ying ‘519 to teach “...the use of a light (5) that is screwably secured in a light holder (Column 2, lines 45-46).”

Applicant maintains that the combination of Kolpasky ‘418 in view of Barnes ‘869 and further in view of Chun-Ying ‘519 does not teach or suggest at least one light source being installed in the chassis of a speaker outside of a diaphragm as required by claim 2 of the present application. In order for the proposed combination of references to render the claim of an application obvious a prima facie case of obviousness must be set forth. In other words, the standard of obviousness is that there must be some suggestion, either in the reference or in the relevant art, of how to modify what is disclosed to arrive at the claimed invention. In addition, “[s]omething in the prior art as a whole must suggest the desirability and, thus, the obviousness of making” the modification to the art suggested by the Examiner. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 U.S.P.Q.2d (BNA) 1434, 1438 (Fed. Cir. 1988), cert. denied,

488 U.S. 825 (1988). Although the Examiner may suggest the teachings of a primary reference could be modified to arrive at the claimed subject matter, the modification is not obvious unless the prior art also suggests the desirability of such modification. *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d (BNA) 1397, 1398 (Fed. Cir.1989). There must be a teaching in the prior art for the proposed combination or modification to be proper. *In re Newell*, 891 F.2d 899, 13 U.S.P.Q.2d (BNA) 1248 (Fed. Cir. 1989). If the prior art fails to provide this necessary teaching, suggestion, or incentive supporting the Examiner's suggested modification, the rejection based upon this suggested modification is error and must be reversed. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d (BNA) 1566 (Fed. Cir. 1990).

Kolpasky '418 teaches or suggests an illuminating speaker assembly. See Kolpasky '418 Abstract. There is nothing in the specification or drawings of Kolpasky '418 which teach or suggest at least one speaker in a chassis, nor does Kolpasky '418 teach or suggest a diaphragm member. Instead the specification of Kolpasky '418 teaches a housing (14) of an illuminating speaker assembly (12). There is no discussion nor are there any structures in the figures which show where the sound is generated from. Therefore, Kolpasky '418 does not teach or suggest a speaker unit or a diaphragm for a speaker unit. Barnes '869 also fails to teach or suggest "at least one light source being installed in the chassis of a speaker outside of the diaphragm..." as presented in claim 2 of the present application. Barnes '869 teaches an apparatus that integrates pedal and foot well lighting in a vehicle with a speaker grille. See Barnes '869 Abstract. Barnes '869 states "[m]embers 30, 32 are arranged so as to be longitudinally parallel to the path of the acoustic energy generated by the audio device." Col. 3, lines

49-51. The specification of Barnes '869 also states "[d]iodes 52 are connected to one another by a porous metal plate or slotted wiring 54 to allow a maximum amount of sound to be transmitted from the audio device through device 18." Col. 4, lines 60-65. Barnes '869 does not teach a diaphragm structure, however, it does teach sound being transmitted through the light emitting device (18). This suggests that the light emitting device (18) is not outside of the diaphragm, which is required by rejected claim 2. Lastly Chun-Ying '519 shows a reading lamp assembly that has a lamp on an arm extending from a base, a speaker in the base and a fragrance holder in the base. There is nothing in the specification or drawings of Chun-Ying '519 that teach or suggest using the reading lamp assembly in a motor vehicle, nor do the specification or drawings teach or suggest "at least one light source being installed in the chassis of a speaker outside of the diaphragm" as required by claim 2 of the present application.

For all of the above reasons Applicant argues that there is no teaching in the proposed combination of references that would even suggest modifying them to arrive at the combination of elements contained in the present application. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 U.S.P.Q.2d (BNA) 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988). Clearly there must be some sort of teaching in the prior art for the proposed combination or modification to be proper. *In re Newell*, 891 F.2d 899, 13 U.S.P.Q.2d (BNA) 1248 (Fed. Cir. 1989). Applicant can only conclude that the Examiner has impermissibly used hindsight to argue that "...at least one light source being installed in the chassis of a speaker outside of a diaphragm..." as recited by rejected claim 2, is taught or suggested by the proposed combination of Kolpasky '418 in view of Barnes '869 and further in view of Chun-Ying '519. Clearly the Examiner



has impermissibly used “hindsight” and used the Applicant’s teaching as a blueprint to hunt through the prior art for the claimed element and to combine them as claimed. In re Zirko 111 F. 3d 887, 42 U.S.P.Q. 2d 1476 (Fed. Cir. 1997). For all of the above reasons Applicant requests removal of the rejection of claim 2 as being rendered obvious by the combination of Kolpasky ‘418 in view of Barnes ‘869 and further in view of Chun-Ying ‘519.

**Whether Claim 3 is rendered Obvious under 35 U.S.C. § 103(a)**

Claim 3 was rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,454,418 to Kolpasky (hereafter Kolpasky ‘418) in view of U.S. Patent No. 6,158,869 to Barnes (hereafter Barnes ‘869) and further in view of U.S. Patent No. 6,283,414 to Quinones (hereafter Quinones ‘414) render claim 3 obvious under 35 U.S.C. §103(a). Claim 3 contains the limitation of “at least one light source being installed on the chassis of a speaker **outside of a diaphragm...**” See claim 1 from which claim 3 depends; [emphasis added].

The Final Office Action indicated that Kolpasky ‘418 taught all of the elements of claim 3 except for “...at least one light source installed outside of the diaphragm.” Final Office Action page 2. The Office Action then indicated that “Barnes, drawn to light attachment to speakers, teaches at least one light source (18) installed outside of the diaphragm (Fig. 2). It would not have been obvious to one of ordinary skill in the art, at the time of the invention, to use the light configuration of Barnes ‘869 in the speaker of Kolpasky ‘418, in order to achieve the best possible lighting for intended surface (abstract).” Final Office Action pages 2-3. Furthermore the Final Office Action relied

upon Quinones '414 to teach "...the use of soldering to attach small lights (column 8, lines 17.20)."

Applicant maintains that the combination of Kolpasky '418 in view of Barnes '869 and further in view of Quinones '414 does not teach or suggest at least one light source being installed in the chassis of a speaker outside of a diaphragm as required by claim 3 of the present application. In order for the proposed combination of references to render the claim of an application obvious a prima facie case of obviousness must be set forth. In other words, the standard of obviousness is that there must be some suggestion, either in the reference or in the relevant art, of how to modify what is disclosed to arrive at the claimed invention. In addition, "[s]omething in the prior art as a whole must suggest the desirability and, thus, the obviousness of making" the modification to the art suggested by the Examiner. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 U.S.P.Q.2d (BNA) 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988). Although the Examiner may suggest the teachings of a primary reference could be modified to arrive at the claimed subject matter, the modification is not obvious unless the prior art also suggests the desirability of such modification. *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d (BNA) 1397, 1398 (Fed. Cir.1989). There must be a teaching in the prior art for the proposed combination or modification to be proper. *In re Newell*, 891 F.2d 899, 13 U.S.P.Q.2d (BNA) 1248 (Fed. Cir. 1989). If the prior art fails to provide this necessary teaching, suggestion, or incentive supporting the Examiner's suggested modification, the rejection based upon this suggested modification is error and must be reversed. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d (BNA) 1566 (Fed. Cir. 1990).

Kolpasky '418 teaches or suggests an illuminating speaker assembly. See Kolpasky '418 Abstract. There is nothing in the specification or drawings of Kolpasky '418 which teach or suggest at least one speaker in a chassis, nor does Kolpasky '418 teach or suggest a diaphragm member. Instead the specification of Kolpasky '418 teaches a housing (14) of an illuminating speaker assembly (12), however, there is no discussion nor are there any structures in the figures which show where the sound is generated from. Therefore, Kolpasky '418 does not teach or suggest a speaker unit or a diaphragm for a speaker unit. Barnes '869 also fails to teach or suggest "at least one light source being installed in the chassis of a speaker outside of the diaphragm..." as presented in claim 3 of the present application. Barnes '869 teaches an apparatus that integrates pedal and foot well lighting in a vehicle with a speaker grille. See Barnes '869 Abstract. Barnes '869 states "[m]embers 30, 32 are arranged so as to be longitudinally parallel to the path of the acoustic energy generated by the audio device." Col. 3, lines 49-51. The specification of Barnes '869 also states "[d]iodes 52 are connected to one another by a porous metal plate or slotted wiring 54 to allow a maximum amount of sound to be transmitted from the audio device through device 18." Col. 4, lines 60-65. Barnes '869 does not teach a diaphragm structure, however, it does teach sound being transmitted through the light emitting device (18). This suggests that the light emitting device (18) is not outside of the diaphragm, which is required by rejected claim 2. Lastly Quinones '414 teaches or suggests an illuminated kite that includes a member of light sources extending along the surface. The illuminated kite of Quinones '414 does not teach or suggest a speaker much less a diaphragm to which a light is mounted outside of. Therefore, the proposed combination of Kolpasky in view of Barnes '869

and then further in view of Quinones '414 does not teach or suggest all of the limitations of claim 3.

For all of the above reasons Applicant argues that there is no teaching in the proposed combination of references that would even suggest modifying them to arrive at the combination of elements contained in the present application. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 U.S.P.Q.2d (BNA) 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988). Clearly there must be some sort of teaching in the prior art for the proposed combination or modification to be proper. *In re Newell*, 891 F.2d 899, 13 U.S.P.Q.2d (BNA) 1248 (Fed. Cir. 1989). Applicant can only conclude that the Examiner has impermissibly used hindsight to argue that "...at least one light source being installed in the chassis of a speaker outside of a diaphragm..." as recited by rejected claim 3, is taught or suggested by the proposed combination of Kolpasky '418 in view of Barnes '869 and further in view of Quinones '414. Clearly the Examiner has impermissibly used "hindsight" and used the Applicant's teaching as a blueprint to hunt through the prior art for the claimed element and to combine them as claimed. *In re Zirko* 111 F. 3d 887, 42 U.S.P.Q. 2d 1476 (Fed. Cir. 1997). For all of the above reasons Applicant requests removal of the rejection of claim 3 as being rendered obvious by the combination of Kolpasky '418 in view of Barnes '869 and further in view of Quinones '414.

### **Conclusion**

In conclusion Applicant notes that none of the proposed combination of references cited by the Examiner render claims 1-10 of the present application obvious.

More specifically none of the combinations of references teach or suggest the limitation of "at least one light source installed in the chassis of a speaker outside of a diaphragm..." See claim 1 of the present application from which claims 2-10 depend. For this reason, Applicant respectfully requests removal of the rejection of claims 1-10 and allowance thereof.

**Appendix Contents**

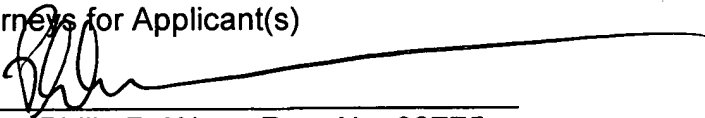
Attached to the end of this Brief is an Appendix A which contains a copy of the current pending claims that are subject to this appeal.

Please send all future correspondence relating to this application to Warn, Hoffmann, Miller & LaLone, P.C., P.O. Box 70098, Rochester Hills, MI 48307.

Respectfully submitted,

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## APPENDIX A

1. A speaker unit for use in a motor vehicle, comprising:  
at least one speaker having a chassis; and  
at least one light source, said at least one light source being installed in the chassis of a speaker outside of a diaphragm and at least one light source is electrically connected to a direct-current network on board the motor vehicle.
2. The speaker unit according to claim 1, wherein the light source is screwed into the chassis.
3. The speaker unit according to claim 1, wherein the light source is soldered into the chassis.
4. The speaker unit according to claim 1, further comprising a single electrical intersection with the vehicle circuit.
5. The speaker unit according to claim 1, wherein the light source is arranged parallel to the axis of a speaker.
6. The speaker unit according to claim 1, wherein the light source is arranged perpendicular to the axis of a speaker.

7. The speaker unit according to claim 1, wherein said at least one light source is followed by a dispersion disk.

8. The speaker unit according to claim 1, wherein said at least one light source is a light-emitting diode.

9. The speaker unit according to claim 8, further comprising a light transmissive material adjacent the light emitting diode for allowing light to be dispersed into the interior of a vehicle.

10. The speaker unit according to claim 9, wherein the light-emitting diode and light transmissive material form one component.